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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,181	04/07/2000	Shojiro Miyake	040679/1047	1509

7590

12/05/2002

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EXAMINER

TURNER, ARCHENE A

ART UNIT

PAPER NUMBER

1775

DATE MAILED: 12/05/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/545,181

Applicant(s)

MIYAKE ET AL.

Examiner

Archene Turner

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 10-12 and 15-25 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8, 10-12, 15, 16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. Newly submitted claim 22-25 directed to an invention that is independent or distinct from the invention originally elected for the following reasons: claims 22-25, are drawn to a process that was withdrawn in the original restriction requirement.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 22-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2-8,10-12,15-16,18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Repenning et al (5,205,188) or Sumitomo (JP6-294307) in view of Sho (5,843,571).

The rejection is maintained for reasons of record in Paper No.8. Applicant's arguments filed 10-21-02 have been fully considered but they are not persuasive. The applicant may not overcome a rejection by attacking the references individually when the rejection is based on the combination (In re Young, 159 USPQ 725 (CCPA 1970)). The rejection is based on the known use of carbon coating in internal combustion

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engines (Repenning et al or Sumitomo) and the known particulars of the carbon coating (Sho). The declaration provided does NOT overcome the art combination, and the rejection stands. The applicant has failed to provide evidence that the coating of Sho does not possess the claimed properties.

4. Claims 2-6,8,10-12,15-16,18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Repenning et al (5,205,188) or Sumitomo (JP6-294307) in view of Dorfman et al.

The rejection is maintained for reasons of record in Paper No.8. Applicant's arguments filed 10-21-02 have been fully considered but they are not persuasive. The applicant may not overcome a rejection by attacking the references individually when the rejection is based on the combination (In re Young, 159 USPQ 725 (CCPA 1970)). The rejection is based on the known use of carbon coating in internal combustion engines (Repenning et al or Sumitomo) and the known particulars of the carbon coating (Dorfman). The declaration provided does NOT overcome the art combination, and the rejection stands. The applicant has failed to provide evidence that the coating of Dorfman does not possess the claimed properties. The applicant is reminded that the friction limitation is only in one claim and the absence of hydrocarbon plasma in an ion beam process does not predict the lack of hydrogen in the film. The specification explicitly says 'low hydrogen' and thus the rejection stands, especially since the presence of hydrogen is *optional* in Dorfman.

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5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Archene Turner, whose telephone number is (703) 308-4344. The Examiner can normally be reached Monday to Thursday from 8:30 AM to 6:00 PM.

A facsimile center has been established in Group 1700, Crystal Plaza 2, 8th floor, reception area. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-3599 (for official after final faxes) or (703) 305-5408 (for all other official faxes). This location should be used in all instances when faxing any correspondence to Art Unit 1775. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1775.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'A. A. Turner', with a stylized, flowing script.

A. A. Turner
Primary Examiner
Group 1700